A

The Polo/Lauren Co LP v RCB Marketing Sdn Bhd

B HIGH COURT (KUALA LUMPUR) — SUIT NO WA-22IP-30–03 OF 2025
EDWIN PARAMJOTHY JC
23 SEPTEMBER 2025

C *Civil Procedure — Summary judgment — Application for — Summary judgment application for trademark infringement under s 54(1) and (2) of Trademarks Act 2019 — Whether there were triable issues — Rules of Court 2012 O 14*

D

Trade Marks — Infringement of — Whether defendant infringed plaintiff's trademark — Identity infringement — Similarity infringement — Whether plaintiff had demonstrated identity infringement as outlined under s 54(1) of Trademarks Act 2019 — Whether plaintiff had established similarity E *infringement pursuant to s 54(2) of Trademarks Act 2019 — Trademarks Act 2019 ss 47, 54(1) & (2)*

The plaintiff, The Polo/Lauren Co LP, was a well-known global fashion company and the registered proprietor of several trademarks in Malaysia, F including the 'POLO' word mark and various 'Polo Player Device' marks for Class 25 goods, namely clothing, footwear and headgear. The defendant on the other hand was a Malaysian company engaged in the business of manufacturing, marketing, and selling apparel products. The plaintiff had instituted a legal action against the defendant, alleging that the defendant had G infringed its trademarks through the unauthorised use of signs identical to or substantially similar to the plaintiff's registered marks. The plaintiff's action was based on s 54(1) and (2) of the Trademarks Act 2019 ('Act 815'), under which the plaintiff sought, among other reliefs, a prohibitory injunction and an order for the delivery of the impugned goods. Subsequently, the plaintiff H filed the present application for summary judgment pursuant to O 14 of the Rules of Court 2012. The issues that arose for the court's determination were as followed: (a) whether the plaintiff had demonstrated identity infringement as outlined under s 54(1) of Act 815; (b) whether the plaintiff had established similarity infringement pursuant to s 54(2) of Act 815; and (c) whether there I were any triable issues arising from the case. The defendant had raised the following arguments in an attempt to demonstrate the existence of triable issues: (i) the 'POLO' word mark was generic and lacked distinctiveness, and therefore the plaintiff's registration of this mark could potentially be invalidated under s 47 of Act 815 ('the first argument'); (ii) the defendant was

entitled to use its own registered marks ('the second argument'); and (iii) the burden of proof was on the plaintiff to prove the likelihood of confusion which was an essential element of infringement and that there was no confusion when the defendant's 'Polo Player Device Signs' were compared with the plaintiff's marks as the marks were visually and aurally different ('the third argument').

Held, allowing the plaintiff's application for summary judgment with costs of RM10,000:

(1) On the totality of the evidence, the court was satisfied that the plaintiff had discharged its burden under s 54(1) of Act 815. The elements were clearly established: (a) the defendant had used a sign identical to the plaintiff's registered 'POLO' word mark; (b) such use occurred in the course of trade, without authorisation from the plaintiff; and (c) the sign was applied to goods — namely, clothing — that were identical to those covered by the plaintiff's registration in Class 25. As such, the defendant had infringed the plaintiff's registered 'POLO' word mark under s 54(1) of Act 815 (see paras 27 & 67).

(2) The court found that the plaintiff had also established all four elements required under s 54(2)(b) of Act 815: (a) the marks were similar in all material respects; (b) the goods were identical and marketed in the same class; (c) the defendant's use of the mark was in the course of trade and without consent; and (d) there existed a likelihood of confusion among the relevant section of the public. Accordingly, the plaintiff's claim under s 54(2)(b) of Act 815 was made out in full. The court therefore satisfied that the defendant had infringed the plaintiff's trademarks under s 54(2)(b) of Act 815 (see paras 59–60 & 67).

(3) The court opined that the first argument could only properly be raised through a counterclaim for invalidity, which had not been filed. The mere possibility that a mark might be challenged for invalidity did not constitute a defence to infringement of a currently valid registration. As for the second argument, the evidence did not establish that the specific signs complained of by the plaintiff were in fact registered trademarks of the defendant. Furthermore, the registration of a trademark did not provide a defence to infringement if that mark itself infringed an earlier registered mark. With respect to the third argument, the plaintiff had already made out its case against the defendant with regards to the visual, aural and conceptual similarities between the defendant's 'Polo Player Device Signs' and the plaintiff's 'Polo Player device marks'. In determining the likelihood of confusion, the court was entitled to give effect to its own opinion and not confined to the evidence of witnesses. In totality, the court found that none of the defendant's arguments raised bona fide triable issue that would warrant a full trial (see paras 62–63 & 65–67).

[Bahasa Malaysia summary

Plaintif, The Polo/Lauren Co LP, merupakan sebuah syarikat fesyen global yang terkenal dan pemilik berdaftar beberapa cap dagangan di Malaysia, termasuk cap perkataan 'POLO' dan pelbagai cap 'Polo Player Device' untuk barangan Kelas 25, iaitu pakaian, kasut dan penutup kepala. Sebaliknya, defendan merupakan sebuah syarikat Malaysia yang terlibat dalam perniagaan pembuatan, pemasaran dan penjualan produk pakaian. Plaintif telah mengambil tindakan undang-undang terhadap defendan, mendakwa bahawa defendan telah melanggar cap dagangannya melalui penggunaan tanda yang sama atau hampir serupa dengan cap dagangan berdaftar plaintif tanpa persetujuan plaintif. Tindakan plaintif adalah berdasarkan s 54(1) dan (2) Akta Cap Dagangan 2019 ('Akta 815'), di mana plaintif memohon, antara lain, injunksi larangan dan perintah untuk penghantaran kepada plaintif barangan yang dipertikaikan. Seterusnya, plaintif memfailkan permohonan semasa untuk penghakiman terus menurut A 14 Kaedah-Kaedah Mahkamah 2012. Isu-isu yang timbul untuk penentuan mahkamah adalah seperti berikut: (a) sama ada plaintif telah menunjukkan pelanggaran 'identity' seperti yang digariskan di bawah s 54(1) Akta 815; (b) sama ada plaintif telah membuktikan pelanggaran 'similarity' menurut s 54(2) Akta 815; dan (c) sama ada terdapat apa-apa isu yang boleh dibicarakan yang timbul daripada kes tersebut. Defendan telah membangkitkan hujah-hujah berikut dalam usaha untuk menunjukkan kewujudan isu-isu yang boleh dibicarakan: (i) cap perkataan 'POLO' adalah generik dan kekurangan ciri tersendiri, dan oleh itu pendaftaran cap ini oleh plaintif berpotensi dibatalkan di bawah s 47 Akta 815 ('hujah pertama'); (ii) defendan berhak menggunakan cap berdaftarnya sendiri ('hujah kedua'); dan (iii) beban pembuktian terletak pada plaintif untuk membuktikan kemungkinan kekeliruan yang merupakan elemen penting pelanggaran dan bahawa tiada kekeliruan apabila 'Polo Player Device Signs' defendan dibandingkan dengan cap plaintif kerana cap tersebut berbeza secara visual dan aural ('hujah ketiga').

Diputuskan, membenarkan permohonan plaintif untuk penghakiman terus dengan kos sebanyak RM10,000:

(1) Berdasarkan keseluruhan keterangan, mahkamah berpuas hati bahawa plaintif telah melepaskan bebannya di bawah s 54(1) Akta 815. Elemen-elemen yang berkaitan telah dibuktikan dengan jelas: (a) defendan telah menggunakan tanda yang serupa dengan cap perkataan 'POLO' berdaftar plaintif; (b) penggunaan sedemikian berlaku dalam perjalanan perdagangan, tanpa persetujuan daripada plaintif; dan (c) tanda tersebut digunakan pada barangan — iaitu pakaian — yang sama dengan yang dilindungi oleh pendaftaran plaintif dalam Kelas 25. Oleh itu, defendan telah melanggar cap perkataan 'POLO' berdaftar plaintif di bawah s 54(1) Akta 815 (lihat perenggan 27 & 67).

(2) Mahkamah mendapati bahawa plaintif juga telah membuktikan keempat-empat elemen yang dikehendaki di bawah s 54(2)(b) Akta 815: (a) cap dagangan tersebut adalah hampir serupa dalam semua aspek material; (b) barangan tersebut adalah serupa dan dipasarkan dalam kelas yang sama; (c) penggunaan cap dagangan oleh defendan adalah dalam perjalanan perdagangan dan tanpa persetujuan; dan (d) terdapat kemungkinan kekeliruan di kalangan orang awam yang berkaitan. Sehubungan itu, tuntutan plaintif di bawah s 54(2)(b) Akta 815 telah dibuktikan sepenuhnya. Oleh itu, mahkamah berpuas hati bahawa defendan telah melanggar cap dagangan plaintif di bawah s 54(2)(b) Akta 815 (lihat perenggan 59–60 & 67).

(3) Mahkamah berpendapat bahawa hujah pertama hanya boleh dibangkitkan dengan sewajarnya melalui tuntutan balas untuk ketidaksahan, yang belum difailkan. Kemungkinan bahawa sesuatu cap mungkin dicabar kerana ketidaksahan tidak membentuk pembelaan terhadap pelanggaran pendaftaran yang sah pada masa ini. Bagi hujah kedua, keterangan tidak membuktikan bahawa tanda khusus yang diadukan oleh plaintif sebenarnya adalah cap dagangan berdaftar defendan. Tambahan pula, pendaftaran cap dagangan tidak memberikan pembelaan terhadap pelanggaran jika cap itu sendiri melanggar cap dagangan berdaftar yang lebih awal. Berkenaan dengan hujah ketiga, plaintif telah mengemukakan kesnya terhadap defendan berkenaan dengan persamaan visual, aural dan konseptual antara 'Polo Player Device Signs' defendan dan 'Polo Player device marks' plaintif. Dalam menentukan kemungkinan kekeliruan, mahkamah berhak untuk menguatkuasakan pendapatnya sendiri dan tidak terhad kepada keterangan saksi-saksi. Secara keseluruhannya, mahkamah mendapati bahawa tiada satu pun daripada hujah defendan yang membangkitkan isu yang boleh dibicarakan secara bona fide yang akan mewajarkan perbicaraan penuh (lihat perenggan 62–63 & 65–67).]

Cases referred to

Bestinet Technology Sdn Bhd v MYFWM System Sdn Bhd & Ors [2022] 9 MLJ 694, HC (folld)

Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd [2009] 5 MLJ 703, HC (refd)

Louis Vuitton Malletier v City Chain Stores (S) Pte Ltd and another matter [2009] SCD 29; [2009] 2 SLR(R) 684, HC (refd)

Maxcare Success Sdn Bhd v Motionquest Sdn Bhd [2024] MLJU 3082, HC (refd)

MI & M Corporation & Anor v A Mohamed Ibrahim [1964] 1 MLJ 392; [1964] CLJU 105, FC (refd)

Neutrogena Corporation and another v Golden Ltd and another [1996] RPC 473, CA (folld)
Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor [2022] 2 MLJ 67, FC (refd)
Parker Knoll Ltd v Knoll International Ltd [1962] RPC 265, HL (refd)
Pianotist Co Ltd, Re (1906) 23 RPC 774, Ch D (refd)
Sandow Ltd's Application, Re (1914) 31 RPC 196, Ch D (refd)
Sinma Medical Products (M) Sdn Bhd v Yomeishu Seizo Co Ltd & Ors [2004] 4 MLJ 358, CA (refd)
Teck Huat (KL) Company Sdn Bhd v OBH Trading Sdn Bhd & Anor [2023] MLJU 2896, HC (refd)
The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] SCD 72; [2006] 2 SLR(R) 690, CA (refd)
Tohtonku Sdn Bhd v Superace (M) Sdn Bhd [1992] 2 MLJ 63, SC (refd)

Legislation referred to

Rules of Court 2012 O 14
Trade Marks Act 1976 (repealed by Trademarks Act 2019) s 10(1)
Trade Marks Act 1994 [UK] s 10(2)
Trade Marks Act 1998 [SG] s 27(1), (2)
Trademarks Act 2019 ss 9(1), 47, 53, 54(1), (2), (2)(b)

Sukumar Karuppiah (Sukumar Karuppiah & Co) for the plaintiff.
Teja Singh Penesar (Teja Singh Penesar & Co) for the defendant.

Edwin Paramjothy JC:

INTRODUCTION

[1] This is the plaintiff's application vide encl 5 for summary judgment against the defendant pursuant to O 14 of the Rules of Court 2012 ('the ROC 2012') for trademark infringement under ss 54(1) and 54(2) of the Trademarks Act 2019 ('the TMA 2019').

[2] Having considered the submissions of both parties and the evidence adduced, I allowed the plaintiff's application for summary judgment on 23 September 2025 with cost of RM10,000. I now state my grounds for doing so.

BACKGROUND FACTS

[3] The plaintiff, The Polo/Lauren Co, LP, is a well-known global fashion company and the registered proprietor of several trademarks in Malaysia, including the 'POLO' word mark and various Polo Player Device marks for Class 25 goods, namely clothing, footwear and headgear. The salient details of

the plaintiff's POLO word mark and the plaintiff's Polo device marks are reproduced below:

NO.	TRADE MARK NO.	TRADEMARK	CLASS	EFFECTIVE DATE	REFERRED IN THIS Judgement as
1.	95009319	POLO	25	7 September 1995	"Plaintiff's POLO word Mark"
	Goods: Jackets, shirts, polo shirts, T-shirts, trousers, suits, slacks, sweaters, neck ties, socks, overcoats, blazers, shorts, belts (clothing), knit shirts and shoes; all included in Class 25.				
2.	M/097832		25	7 December 1982	"Plaintiff's Polo Player Device Marks"
	Goods: Men's and women's clothing; all included in Class 25.				
3.	95009325		25	7 September 1995	
	Goods: Jackets, shirts, polo shirts, t-shirts, trousers, suits, slacks, sweaters, neck ties, socks, overcoats, blazers, shorts, belts (clothing), knit shirts and shoes; all included in class 25.				

[4] The defendant on the other hand is a Malaysian company engaged in the business of manufacturing, marketing, and selling apparel products.

[5] It is the plaintiff's case that the defendant has engaged in the unauthorised use of trade marks that are either identical to, or constitute substantial reproductions of, the plaintiff's registered 'POLO' word mark and Polo Player device marks ('the plaintiff's marks').

[6] According to the plaintiff, these impugned marks are affixed to goods sold by the defendant and are prominently featured in the course of trade, including on the defendant's e-commerce platform as well as at its physical

retail outlets. The representations which the plaintiff contends constitute such unauthorised use are reproduced below:

Defendants Marks	TO BE REFERRED TO AS
POLO	"Defendant's word sign"
	"Defendant's Polo Player Device Signs"
RCBPC	

Defendant's Word Sign and Polo Player Device Signs	

[7] It is pertinent to highlight here as well that the defendant's registered the

mark, in Class 25, TM No 2016069124, which incorporates a device of *a polo player, without a mallet*, and the letters, 'RCBPC' is not the subject matter before this court.

[8] On 28 March 2025, the plaintiff instituted the present proceedings against the defendant, alleging that the defendant had infringed its trademarks through the unauthorised use of signs identical to or substantially similar to the plaintiff's registered marks. The plaintiff's action is anchored on ss 54(1) and 54(2) of the TMA 2019, under which the plaintiff seeks, among other reliefs, a prohibitory injunction and an order for the delivery of the impugned goods.

[9] Thereafter, on 13 May 2025, the plaintiff took out the instant application for summary judgment (encl 5).

ANALYSIS

[10] The matter before me presents three key issues for determination:

(a) has the plaintiff demonstrated identity infringement as outlined under s 54(1) of the TMA 2019?

(b) has the plaintiff established similarity infringement pursuant to s 54(2)(b) of the TMA 2019? and

(c) are there any triable issues arising from the case?

[11] I shall address each of these issues in turn.

Identity infringement under s 54(1) of the TMA 2019

[12] The relevant provision for identity infringement under the TMA 2019 is s 54(1) which provides as follows:

> Section 54(1):
>
> A registered trademark is infringed by a person who, without the consent of the proprietor of the trademark, uses in the course of trade a sign which is identical with the trademark in relation to goods or services which are identical with those for which it is registered.

[13] The legal test applicable to identity infringement under s 54(1) of the TMA 2019 is well-articulated in the leading treatise *Law and Practice of Intellectual Property Malaysia* (Sweet & Maxwell) at p 291, which observes that s 54(1) of the TMA 2019 contemplates infringement where two elements coincide: (a) the use of a sign which is identical to a registered trademark, and (b) the use of that sign in relation to goods or services which are identical to those for which the mark is registered. This interpretation is consistent with

Kerly's Law of Trade Marks and Trade Names (14th Ed) and cited in *Louis Vuitton Malletier v City Chain Stores (S) Pte Ltd and another matter* [2009] SCD 29; [2009] 2 SLR(R) 684, which emphasises that a sign will be identical where it reproduces, without modification or addition, all the elements constituting the mark or contains only differences so insignificant that they go unnoticed by the average consumer.

[14] Section 54(1) of the TMA 2019 governs *identity infringement* and encapsulates the essence of trademark protection: to safeguard the proprietor's exclusive right to use the mark in relation to the goods or services for which it is registered, and to prohibit others from appropriating that mark in the marketplace. Its object is to confer upon the proprietor an absolute monopoly over the use of an identical sign in respect of identical goods, dispensing with the need to prove confusion or deception

[15] Section 54(1) of the TMA 2019 is in *pari materia* to the law in Singapore as provided under s 27(1) of the Trade Marks Act 1998 (Chapter 332) ('the Singapore TMA'), which reads as follows:

> 27(1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

[16] Singapore's position with respect to the *identity infringement claim* is succinctly set out in a leading Singapore treatise, *Cases, Materials and Commentary on Singapore Intellectual Property Law* (2018) ('Commentary on Singapore IP Law Treatise'), the relevant extract of which is produced below:

> The Court of Appeal has described the TMA as providing a 'cascading regime for trade mark protection' that varies according to the degree of similarity between the registered mark and the allegedly infringing sign, and the degree of similarity between the goods or services for which the mark is registered and those in relation to which the allegedly infringing sign is used. In *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another* [2013] 2 SLR 941 at [14]–[16], Sundaresh Menon CJ (on behalf of the court) explained and applied the regime:
>
> > 14 ... At the simplest level, where the registered mark and the allegedly infringing sign are identical and the goods or services for which the mark is registered and those in relation to which the allegedly infringing sign is used are also identical, infringement is constituted without more under s 27(1) of the Act.
> >
> > ...
> >
> > 15 The trade mark infringement claim under s 27(2) of the Act occupies a space between the preceding two categories of infringement. Specifically, for its claim under s 27(2)(b) to succeed, Hai Tong has to prove the following elements:
> >
> > (a) the (defendant's) Sign is similar to the (its registered) Mark;

(b) the Sign is used in relation to goods or services identical with or similar to those for which the ... Mark is registered; and

(c) on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public.

16 These requirements are cumulative, so that if either of the first two elements is not satisfied, an inquiry into the third will not arise and the claim under s 27(2)(b) of the Act will fail (see this court's observations in *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ('Sarika') at [14] and *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ('Polo (CA)') at [8]) ... (Emphasis added.)

[17] The *Commentary on Singapore IP Law Treatise* had expounded on the requirements of Identity Infringement Claim as follows:

(a) Section 27(1)

To succeed under section 27(1), first, the plaintiffs registered mark and the defendant's sign and, secondly, the goods or services in question must be identical. The test is a strict one that is exactly as it says — there must be identity. Anything less than complete identity, no matter how minor the difference, would fall short of this criterion ...

[18] From the authorities citied above, it is clear that the principle that identical reproduction of a registered mark on identical goods constitutes the highest degree of encroachment on the proprietor's exclusive right. It follows that such conduct, absent consent, strikes at the very core of trademark protection. Critically, in such circumstances, the statutory language does not require proof of a likelihood of confusion. The requirements to prove infringement under s 54(1) of the TMA 2019 are represented in below:

SECTION 54(1) TMA 2019		
Item	ASPECTS	REQUIREMENT
a.	Trademark/Sign	Identical
b.	Goods/Services	
c.	Use of Sign in the Course of Trade	Required
d.	Without Consent	
e.	Likelihood of Confusion	Not Required

[19] In outlining the first issue, learned counsel for the plaintiff contended that the defendant has, in the course of trade, made use of signs identical to its registered 'POLO' word mark. This mark is registered in respect of goods falling within Class 25, encompassing clothing, footwear, and headgear. Learned counsel asserted that the defendant has affixed this identical sign to goods of the very same class, thereby engaging in conduct that constitutes

infringement within the meaning of s 54(1) of the TMA 2019.

[20] In the present case, I find that the defendant has adopted the precise 'POLO' word mark — identical in spelling, form, and presentation — and applied it to clothing items that fall squarely within Class 25. The defendant does not deny that the goods to which the mark is applied are identical to those covered by the plaintiff's registration. Nor has it adduced any evidence of licence, authorisation, or other lawful basis for its use.

[21] The defendant seeks to resist the claim on the ground that the plaintiff's 'POLO' word mark is generic and devoid of distinctiveness. With respect, that argument cannot withstand scrutiny. The defendant itself has adopted the identical mark in its trade conduct — a fact that, by its very nature, negates any assertion of genericness. It is logically inconsistent to appropriate a mark for commercial advantage while simultaneously denying its capacity to distinguish source.

[22] Moreover, the plaintiff's 'POLO' word mark has been on the register since 7 September 1995. It would therefore have satisfied the threshold criteria for registration under s 10(1) of the now-repealed Trade Marks Act 1976 ('TMA 1976'), which required that a registrable mark comprise an invented word, a distinctive representation of a name, or a mark capable of distinguishing goods in the course of trade. Having remained on the register for nearly three decades, the mark has withstood the test of time. Pursuant to s 53 of the TMA 2019, any challenge to its validity based on absolute grounds must be brought within five years of registration; beyond that, its validity is conclusively presumed. A mark that has been registered and used for a substantial period acquires both de jure and de facto distinctiveness. Once entered in the register, validity is presumed unless successfully challenged under statutory grounds for invalidity within the prescribed limitation period.

[23] The plaintiff is therefore entitled to rely on the statutory presumption of validity, and the defendant's assertion of genericness must be rejected in the absence of compelling evidence to the contrary.

[24] The law admits of no ambiguity. Where the infringing sign and the goods are both identical, infringement is made out once use in the course of trade and absence of consent are established. This reflects the rationale of s 54(1) of the TMA 2019, which affords robust and automatic protection to registered trademarks against acts of direct appropriation. Once the defendant's sign reproduces all essential elements of the registered mark without alteration, the law presumes infringement, and no inquiry into confusion or consumer perception is necessary.

[25] The learned authors of *Law and Practice of Intellectual Property Malaysia* have observed that an action for infringement under s 54(1) of the TMA 2019 — where the infringing goods involve an identical reproduction of the registered proprietor's trademarks and goods — may warrant the Plaintiff's application for summary judgment. In circumstances where the defence fails to dispute the identical nature of the trademarks and goods or services, and absent any other viable defences, such as express or implied consent or a dispute over rightful ownership of the trademark, the case is prima facie suitable for summary judgment. This principle finds support in *Teck Huat (KL) Company Sdn Bhd v OBH Trading Sdn Bhd & Anor* [2023] MLJU 2896, which underscores the appropriateness of summary judgment in such clear-cut cases.

[26] In this regard, I accept the submission of learned counsel for the plaintiff that this is a proper case for summary determination. In *Teck Huat,* the High Court granted summary judgment in analogous circumstances, holding that where the defendants had used the plaintiff's registered mark on packaging without consent, and where no bona fide triable issue was raised, summary relief was appropriate. The same reasoning applies here.

[27] On the totality of the evidence, I am satisfied that the plaintiff has discharged its burden under s 54(1) of the TMA 2019. The elements are clearly established:

(a) the defendant has used a sign identical to the plaintiff's registered 'POLO' word mark;

(b) such use occurred in the course of trade, without authorisation from the plaintiff; and

(c) the sign was applied to goods — namely, clothing — that are identical to those covered by the plaintiff's registration in Class 25.

Similarity infringement under s 54(2)(b) of the TMA 2019

[28] The plaintiff's second claim is based on s 54(2)(b) of the TMA 2019 whereby the defendant's Polo Player device signs are substantially similar to the plaintiff's Polo Player device marks. Learned counsel for the plaintiff emphasised that the marks were applied in the course of trade without consent, and that the similarities are such as to give rise to a real likelihood of confusion.

[29] Now, s 54(2)(b) captures the broadest and most common category of infringement — covering 'similar marks on identical or similar goods', where the statutory purpose is to prevent consumer deception and protect goodwill arising from the distinctive character of registered trademarks.

[30] The relevant provision for similarity infringement under the TMA

2019 is s 54(2)(b) which provides as follows:

> Section 54(2):
>
> A registered trademark is infringed by a person who, without the consent of the proprietor of the trademark, uses in the course of trade a sign where —
>
> (a) the sign is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered; or
>
> (b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered, and the use of the sign is likely to cause confusion on the part of the public.

[31] The requirements to prove infringement under s 54(2)(b) of the TMA 2019 is represented in the table below:

SECTION 54(2)(b) TMA 2019		
Item	ASPECTS	REQUIREMENT
a.	Trademark/Sign	Similar
b.	Goods/Services	Identical/Similar
c.	Use of Sign in the Course of Trade	Required
d.	Without Consent	
e.	Likelihood of Confusion	

[32] In the recent decision of *Maxcare Success Sdn Bhd v Motionquest Sdn Bhd* [2024] MLJU 3082, the High Court elucidated the requirements for establishing infringement under s 54(2)(b) of the TMA 2019 in the following manner:

> [16] From the provisions in s 54(2)(b) of the TMA 2019, in order to prove infringement of the plaintiff's Mark, the plaintiff must establish the following:
>
> (a) that the Maxxoil Mark is similar to the plaintiff's Mark;
>
> (b) that the defendant trades in goods or services similar to those for which the plaintiff's Mark is registered;
>
> (c) that the Maxxoil Mark was used in the course of the defendant's trade;
>
> (d) that the defendant used the Maxxoil Mark without the plaintiff's consent; and
>
> (e) that the use of the Maxxoil Mark by the defendant resulted in the likelihood of confusion on the part of the public.

[33] From *Maxcare Success*, it is evident that the High Court distilled the requirements for a successful action under s 54(2)(b) into five distinct elements:

(a) there is similarity of marks ('similarity of marks requirement'); A

(b) identical or similar goods ('identical or similar goods requirement');

(c) use of marks in the course of trade without consent of the registered proprietor ('use of marks in the course of trade without consent requirement'); and B

(d) likelihood of confusion on the part of the public ('likelihood of confusion requirement').

[34] The court went on to observe that each of these elements must be proven before a finding of infringement can properly be made. C

[35] The above requirements align closely with the statutory framework of s 54(2), which codifies two forms of infringement — identical or similar signs used on identical or similar goods — both hinging upon a likelihood of confusion. The provision is in *pari materia* with s 27(2) of the Singapore Trade Marks Act 1998 and s 10(2) of the UK Trade Marks Act 1994, and thus comparative jurisprudence from those jurisdictions may assist the Malaysian courts in their interpretation and application of the same. D

E

[36] While the European Court of Justice has developed the 'global appreciation' approach, emphasising interdependence between similarity of marks and goods, the Singapore Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] SCD 72; [2006] 2 SLR(R) 690 preferred a 'step-by-step' analysis, considering each element sequentially: similarity of marks, similarity of goods, and finally, likelihood of confusion. Although Malaysian jurisprudence has not definitively adopted either approach, the *Bestinet Technology Sdn Bhd v MYFWM System Sdn Bhd & Ors* [2022] 9 MLJ 694 ('Bestinet Technology') decision indicates a leaning toward the step-by-step analysis, consistent with our regional legislative lineage. Applying these principles to the case at hand, I turn first to consider whether the plaintiff has made out its case on similarity infringement, by reference to the five distinct elements set out in the preceding paragraph of this judgment. F G

Similarity of marks requirement H

[37] With respect to the similarity of marks requirement, the High Court in *Bestinet Technology* had succinctly laid out the principles as follows:

> [32] Relying on *BRG Brilliant Rubber Goods (M) Sdn Bhd v Santa Barbara Polo & Racquet Club Management Inc (Pendaftar Cap Dagangan Malaysia, interested party) and another case* [2017] 7 MLJ 244, *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63; [1992] 2 CLJ 1153, *Al Baik Fast Food Distribution Co SAE*, the defendant's counsel submitted that the *plaintiff's and defendants' marks when taken as a whole showed stark contrasts between the two where the defendants had produced* I

huge visual, conceptual and phonetic comparisons between these two marks as indicated in the seven points above. I agree with the defendants' counsel on the requirements that must be established by the plaintiff as set out in those authorities.

[33] The law is trite that in determining this issue, I must consider the two words 'FWCMS' and 'MyFWMS', judge them both by their look and their sound (if that can be decipher), and consider the goods or the services to which the marks are to be applied: *Pianotist Co Ltd, Re* (1906) 23 RPC 774, Tohtonku Sdn Bhd. (Emphasis added.)

[38] The case of *Bestinet Technology* propounded the modern approach, which recognises three principal dimensions of similarity:

(a) visual;

(b) aural (or phonetic); and

(c) conceptual,

in the assessment of similarity of marks. The assessment must be undertaken holistically, bearing in mind the overall impression produced by each mark rather than focusing on minute details.

[39] In assessing the similarity between the registered trademark and the alleged infringing sign, the general approach is that the trademarks must be compared as a whole. In assessing these three principal dimensions, the weight and importance to be attached to each of them must be evaluated as well, taking into account the category of goods or services in question and the circumstances in which they are marketed. Accordingly, the assessment must be based on the overall impression given by the trademarks and not based on an overly detailed analysis of the intricacies.

[40] There is a line of authorities which established that, in comparing the trademarks, particular regard must be had to the 'essential feature' of the registered trademark. This has been described to be 'some feature in it which strikes the eye and fixes itself in the recollection' which the registered trademark has come to be remembered by. However, in undertaking a holistic comparison, similarities in the essential features of the registered trademark should not be the determinative element. Competing trademarks are to be compared as whole and the similarities must be based on the overall impression, bearing in mind the distinctive and dominant components.

[41] When comparing the competing trademarks, courts often employ what is commonly referred to as the 'imperfect recollection test'. This approach was first espoused in the UK case of *Re Sandow Ltd's Application* (1914) 31 RPC 196, which was adopted affirmatively by the Federal Court in *MI & M*

Corporation & Anor v A Mohamed Ibrahim [1964] 1 MLJ 392; [1964] CLJU 105. The approach considers whether a consumer viewing the alleged infringing sign in the absence of the registered trademark, and based only on their general recollection of the registered trademark, would think the alleged infringing sign was the registered trademark. The rationale is that consumers would not have perfect memory of every detail of the registered trademark and often will not encounter the infringing sign at the same time and place as the registered trademark to conduct a detailed comparison. In such a situation, there is a general presumption that consumers would more readily remember similarities rather than differences in their imperfect recollection.

[42] Applying this to the case at hand I agree with learned counsel for the plaintiff that there are *visual* similarities in the defendant's Polo Player Signs which has incorporated the essential feature which is present in the plaintiff's Polo Player device marks in Class 25. I find this to be the plaintiff's 'Core Trade Mark'.

[43] It cannot be disputed that the polo player device in the defendant's Polo Player device signs is substantially similar to the plaintiff's Polo Player device marks in Class 25. Members of the public are likely to refer to the defendant's Polo Player device signs as a 'polo player' or simply as 'polo', depicting the game of polo. Therefore, there is a high degree of *visual* similarity between both the defendant's Polo Player device signs and the plaintiff's Polo Player device marks in Class 25. Where device marks evoke the same mental association — such as two depictions of a polo player — *conceptual* similarity is established even if stylistic differences exist. What matters is the dominant visual cue that lingers in the consumer memory.

[44] As emphasised in *Sinma Medical Products (M) Sdn Bhd v Yomeishu Seizo Co Ltd & Ors* [2004] 4 MLJ 358, it is the essential and dominant feature of a mark that 'strikes the eye and fixes itself in the recollection' that carries the most weight. On this basis, I find that visual similarity is clearly established.

[45] Again, members of the Malaysian public are likely to refer to both the plaintiff's Polo Player device marks and the defendant's Polo Player device signs verbally as 'polo player' or simply 'polo', referencing the game of polo. This common mode of reference establishes a significant degree of *aural* similarity between the two. Furthermore, since the plaintiff's Polo Player device marks inherently evoke the concept of the game of polo there exists a high degree of *conceptual* similarity between the defendant's Polo Player device signs and the plaintiff's Polo Player device marks.

[46] In the final analysis I am convinced that the plaintiff has adduced *visual*, *aural*, and *conceptual* comparisons between the defendant's Polo Player device

signs and the plaintiff's Polo Player device marks. The plaintiff's core mark features a polo player astride a horse in motion, an image mirrored with striking resemblance in the impugned marks. I am convinced in this regard that the 'similarity of marks' requirement is met.

Identical or similar goods

[47] The 'identical or similar goods' requirement presents no difficulty. The defendant's goods —primarily clothing and accessories — fall within Class 25, the same class for which the plaintiff's trademarks are registered. Goods are considered 'similar' if they share the same trade channels, target consumers, or commercial function, even when not identical. In *Parker Knoll Ltd v Knoll International Ltd* [1962] RPC 265, similarity was found where the goods appealed to the same purchasing public or were likely to be encountered together in trade.

NO.	TRADE MARK NO.	TRADEMARK	CLASS	GOODS
1.	M/097832		25	Men's and women's clothing; all included in Class 25.
2.	95009325		25	Jackets, shirts, polo shirts, t-shirts, trousers, suits, slacks, sweaters, neck ties, socks, overcoats, blazers, shorts, belts (clothing), knit shirts and shoes; all included in class 25.

[48] It is to be observed that the underlined items above are identical and/or similar to the defendant's goods based on the sample purchases made through the defendant's retail stores and exhibited in the plaintiff's affidavit in support. Therefore, I find that the goods concerned in respect of this infringement claim under s 54(2)(b) of the TMA 2019 are identical and/or similar, which fulfills the identical or similar goods requirement.

Use in the course of trade without consent

[49] This requirement is similarly established by the plaintiff. The defendant has affixed the objected marks to its merchandise and marketed them through retail outlets, without any evidence of authorisation from the plaintiff. This is evidenced in the plaintiff's affidavits, including contemporaneous photographs and purchase receipts. Such commercial use constitutes 'use in the

course of trade' within the meaning of s 54(2) of the TMA 2019, a concept interpreted broadly to encompass acts that promote, distribute, or offer goods under the infringing sign.

Likelihood of confusion requirement

[50] In assessing the likelihood of confusion, Malaysian courts continue to be guided by the principles enunciated in the oft-cited *Pianotist* case (*Pianotist Co Ltd, Re* (1906) 23 RPC 774), adopted by the Supreme Court in *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63. The '*Pianotist* test' requires the court to consider the marks by their look and sound, the nature of the goods, the class of consumers, and all surrounding circumstances. In the *Pianotist* case the court held as follows:

> You must take the two words. You must judge them, both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those marks are used in a normal way as a trade mark of the goods of the respective owners of the marks.

[51] The Federal Court in *Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor* [2022] 2 MLJ 67 had provided a summary in respect of the test for likelihood of confusion and/or deception, as follows:

> [104] Upon a full consideration of the principles and authorities aforementioned, the *test for likelihood of confusion and/or deception* would be as follows:
>
> (a) both side-by-side comparison and the *Imperfect Recollection Test* must be satisfied;
>
> (b) the comparison is made in terms of *phonetic, visual, trade channel, and idea aspects of the marks*;
>
> (c) the purpose of such comparison is to determine whether the defendant's mark contains *essential features* of the plaintiff's registered trademark, which strike the eye and fix themselves in the recollection of the users of the plaintiff's goods;
>
> (d) the court shall then take into account all surrounding circumstances and apply the Imperfect Recollection Test, bearing in mind the outcome of the comparison, in order to determine whether it is likely that *ordinary consumer with ordinary memory who would be likely to buy the goods would be deceived and think that the defendant's mark is the same as the plaintiff's registered trademark. In other words, the test of whether one trademark is confusingly similar is an objective test and the test is that of an ordinary person with an appropriate level of literacy* (*Merck KGaA v Leno Marketing (M) Sdn Bhd* [2017] MLJU 1011; [2017] 1 LNS 1006); and
>
> (e) in determining this test, *the court is entitled to give effect to their own*

opinions, and not confined to the evidence of witnesses. (Emphasis added.)

[52] It is well-established that in order to determine the existence of confusion, the court is entitled to look beyond the competing trademarks and the goods or services. The High Court in *Bestinet Technology* adopted the principles from Singapore case law that the courts must take a holistic view of 'extraneous factors' to determine whether there is a likelihood of confusion on the facts of each case, which could be equated to 'all the surrounding circumstances'. This principle is also now statutorily enshrined in s 9(1) of the TMA 2019 which provides that 'In determining whether the use of a trademark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trademark'.

[53] There is no definitive or exhaustive list of these extraneous factors which ought to be considered by the court. Much will depend on the circumstances of each case. Some common factors include the sales channel, common practices of the trade and the manner in which the goods or services are marketed and sold. The visual, aural or conceptual aspects of the opposing trademarks may carry differing weight and importance depending on the conditions under which the goods or services may be present on the market.

[54] Speaking of likelihood of confusion, it bears emphasis that actual confusion need not be demonstrated; a real and tangible likelihood suffices (refer *Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd* [2009] 5 MLJ 703). This aligns with settled jurisprudence, including *Sinma Medical Products*. Proof of actual confusion, while helpful, is not mandatory. Courts may infer likely confusion from inherent similarity, market context, and consumer perception evidence, applying an objective standard.

[55] The likelihood of confusion must be on 'the part of the public', which does not mean the entire world at large but rather the relevant consumer of the particular goods or services in question. The average customer is deemed to be reasonably well informed and reasonably observant and circumspect.

[56] The test of likelihood of confusion requires confusion on the part of a 'substantial portion', which has been construed to mean that there must not be an insubstantial number of the relevant public that are confused. This standard is above de minimis and must be appreciable, though it is not necessary to show that a majority of the public is confused. The 'average consumer' is deemed to be reasonably observant but not hypercritical. The test balances commercial realism with consumer protection, guarding against misrepresentation that would impair the distinctive function of the registered mark. The court is

entitled to form its own opinion, informed but not bound by witness testimony or survey evidence (*Neutrogena Corporation and another v Golden Ltd and another* [1996] RPC 473).

[57] Applying the above principles, I agree with learned counsel for the plaintiff that the issue of likelihood of confusion is made out in this case between the defendant's Polo Player device signs and the plaintiff's Polo Player device marks in Class 25. Both parties are operating in the same market segment, retailing, inter alia, clothing. This adds to the likelihood of confusion. Given that the similarity of marks in respect of identical and/or similar goods had been established above, the defendant's Polo Player device signs when promoted and used on their goods are calculated to or at the very least, are likely to deceive or cause confusion to the public in Malaysia.

[58] I also note the commercial strength of the plaintiff's mark, which has been in use in Malaysia since 1989 and promoted since 1991. It is the plaintiff's case that with a combined revenue exceeding RM228m over the last two financial years, the plaintiff's mark enjoys significant goodwill and market penetration. These are weighty considerations when assessing the likelihood of confusion.

[59] Drawing these threads together, I am satisfied that the plaintiff has established all four elements required under s 54(2)(b) of the TMA 2019:

(a) the marks are similar in all material respects;

(b) the goods are identical and marketed in the same class;

(c) the defendant's use of the mark is in the course of trade and without consent; and

(d) there exists a likelihood of confusion among the relevant section of the public.

[60] Accordingly, the plaintiff's claim under s 54(2)(b) of the TMA 2019 is made out in full. I am therefore satisfied that the defendant has infringed the plaintiff's trademarks under s 54(2)(b) of the TMA 2019.

Whether there are triable issues

[61] The defendant has raised several arguments in an attempt to demonstrate the existence of triable issues that would warrant a full trial.

[62] First, learned counsel for the defendant argued that the 'POLO' word mark is generic and lacks distinctiveness, and therefore the plaintiff's registration of this mark could potentially be invalidated under s 47 of the

TMA 2019. However, with respect, this argument could only properly be raised through a counterclaim for invalidity, which has not been filed. The mere possibility that a mark might be challenged for invalidity does not constitute a defense to infringement of a currently valid registration.

[63] Second, the defendant argued that it is entitled to use its own registered marks. However, the evidence does not establish that the specific signs complained of by the plaintiff are in fact registered trademarks of the defendant. Furthermore, the registration of a trademark does not provide a defense to infringement if that mark itself infringes an earlier registered mark.

[64] The defendant does not have any registrations for any of the following defendant's Polo Player device signs; , (with a mallet) and . These signs are infringing the plaintiff's Polo Player device marks. Since these signs are not registered they are not protected under the TMA 2019 and the plaintiff has made out its case for *similarity infringement* against the defendant for the infringement of the plaintiff's Polo Player device marks under s 54(2)(b) of the TMA 2019.

[65] Learned counsel for the defendant also argued that the burden of proof is on the plaintiff to prove the likelihood of confusion which is an essential element of infringement and that there is no confusion when the defendant's Polo Player device signs are compared with the plaintiff's marks as the marks are visually and aurally different. In this regard the plaintiff has already made out its case against the defendant with regards to the visual, aural and conceptual similarities between the defendant's Polo Player device signs and the plaintiff's Polo Player device marks. In determining the likelihood of confusion, the court is entitled to give effect to its own opinion and not confined to the evidence of witnesses (refer *Ortus Expert White*).

[66] Having considered all the learned counsel's arguments, I find that none of them raises a bona fide triable issue that would warrant a full trial.

CONCLUSION

[67] For the reasons stated above, I am satisfied that:

(a) the defendant has infringed the plaintiff's registered 'POLO' word mark under s 54(1) of the TMA 2019 by using identical signs on identical goods without the plaintiff's consent and in the course of trade; and

(b) alternatively, the defendant has infringed the plaintiff's registered marks under s 54(2)(b) of the TMA 2019 by using similar signs on identical goods in circumstances likely to cause confusion on the part of the public; and

(c) the defendant has failed to raise any bona fide triable issue that would warrant a full trial. Accordingly, the plaintiff is entitled to summary judgment.

[68] In the circumstances, I hereby order that:

(1) the defendant be restrained by way of injunction whether acting by themselves, their servants, agents, associated companies, businesses, present and future affiliated companies and businesses or any of them or otherwise howsoever from doing the following acts or any of them, that is to say:

(a) from using, in the course of trade by selling, offering for sale or advertising goods (both in print medium and online, including but not limited to the defendant's website, https://www.poloclub.com.my/*)* the following marks:

(i) POLO as registered in the plaintiff's favour through Trademark Registration No 95009319;

(ii) ;

(iii)

; and

(iv)

(b) enabling, assisting, causing, procuring or authorizing others to do any of the acts aforesaid.

(2) an order for delivery up of the following to the plaintiff's solicitors within seven days from the date of judgment and for the defendant to within seven days after such delivery up thereafter to file and serve affidavit(s) on the plaintiff's solicitors verifying the same:

(a) all goods bearing the defendant's prohibited marks and/or all items, packaging materials, inserts, wrappers or other printed materials in the possession custody and/or control of the defendant in relation to which the continued retention, use of or dealing with by the defendant would be a breach of the injunction prayed for; and

(b) all documents and records including but not limited to all invoices, books, contracts, delivery notes, orders, bills, correspondence, custom declaration forms and other articles and materials in connection with or relating to the storage, supply, distribution, import, export, sale, offer for sale or disposal of the infringing goods bearing the defendant's prohibited marks which are in the possession custody or control of the

A defendant, their servants or agents or any of them.

(3) an order for the disclosure by the defendant of the following within seven days from the date of judgment coupled with affidavit(s) to be filed and served on the plaintiff's solicitors verifying such disclosure:

B

(a) the name and address of everyone who has supplied the defendant or offered to supply the defendant with defendant's prohibited marks;

(b) the name and address of retail customers to whom the defendant has supplied or offered to supply with defendant's prohibited marks; and

C

(c) full details of the dates and quantities of every such supply and offer.

(4) an inquiry as to damages or, at the plaintiff's option, an account of profits and an order for payment of all sums found due to the making of such inquiry or that taking of such account together with interest thereon at such rate and for such period as this honourable court deems fit;

D

(5) where the plaintiff elects for an account of profits under para (4) above, an order that the defendant prepares all the necessary accounts, furnishes all relevant documentation and make all necessary enquiries;

E

(6) an order for payment of all sums found due under para (4) above together with interest thereon at 5%pa from the date of judgment until full settlement thereof;

F

(7) costs in the sum of RM10,000 be paid to the plaintiff, subject to allocatur fees.

G *Plaintiff's application for summary judgment allowed with costs of RM10,000.*

Reported by Dzulqarnain Ab Fatar

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